

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/614,016

**Applicant(s)**

DELACOUR ET AL.

**Examiner**

Lakshmi S. Channavajjala

**Art Unit**

1611

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 15 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-63.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Lakshmi S Channavajjala/  
Primary Examiner, Art Unit 1611

Continuation of 11, does NOT place the application in condition for allowance because: 1. The terminal disclaimer filed on 1-15-08 over US Patent No. 6,565,862 has been considered and accordingly, the double patenting rejection of instant claims over claims of the above patent has been withdrawn.

2. In response to the clarification of the double patenting rejection of instant claims over US 7,094,842, examiner here with clarifies that the instant claims are no longer rejected as being obvious over the claims of US 7,094,842.

3. With respect to the arguments regarding the double patenting rejection over US 6,689,345 patent, it is argued that instant invention relates to composition having a pasty or pulverulent texture, imparted by the claimed ratio of the organopolysiloxane to the particulate phase. It is argued that the rejection failed to provide any reasons why a skilled artisan, without any guidance from the '345 patent, would modify the composition of the patented claims to arrive at the instant claimed invention. Applicants' arguments are not found persuasive because instant claims do not recite the argued limitations. Accordingly, the motivation to optimize the amounts of organopolysiloxane and the particulate phase in the composition of '345 patent claims need not be the same as that of the applicants'. Additionally, applicants have not shown that the composition of '345 patent does not result in the claimed pasty or pulverulent mixture, whereas the patent claims describe a homogenous composition. Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the organopolysiloxane and the particulate phase so as to achieve the desired make-up composition that is homogenous.

4. With respect to the rejections under 35 USC 103(a) over US patents 6403704, 6689345 and 6565862, applicants arguments have been considered but not found persuasive because as explained above, applicants argued features are not claimed in the instant invention. Accordingly, the motivation to optimize the ratios of the art recognized components need not be the same as that of the instant. With respect to the showing of the ratios taught by examples of the prior art as an evidence of unobviousness, it is to be noted that the prior art teachings are not limited to examples and should be considered as a whole. Further, applicants have not shown that the prior art compositions do not result in pasty or pulverulent compositions at the amounts disclosed. Accordingly, the rejections have been maintained.